

JAN 28 2008

Application Serial No. 10/796,488

Attorney Docket No. 10040374-1

Reply to Final Office Action dated November 26, 2007

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**REMARKS**

The foregoing amendments and following remarks are in response to the Final Office Action mailed on November 26, 2007. Claims 1-18 were amended. No claims were cancelled, and claims 1-18 are currently pending. Applicant respectfully requests withdrawal of the pending rejection and allowance of the pending claims.

**A. Preliminary Matters**

Applicant has amended the claims to delete reference numbers. The embodiments disclosed in the specification are provided as a non-limiting example. The claims are not limited to the elements disclosed in the specification that are identified by the deleted reference numerals. Applicant has also reformatted claims 1 and 14.

**B. Rejections Under 35 U.S.C. §§ 102(b) and 102(e)****Anticipation Rejection over McGrath**

Claims 1, 2, 5, 9, 12, 14, and 18 stand rejected under U.S.C. § 102(b) as being anticipated by McGrath (U.S. Patent No. 5,192,503). Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 1 and its dependent claims set forth a slide, a substrate backing, "a gasket . . . having a perimeter," and a "spacer positioned outside the perimeter and providing a pivot between the substrate backing and the slide." Claim 14 and its dependant claims set forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

In sharp contrast, McGrath discloses a slide 50, a base plate 12, an annular gasket 36 between the slide and base plate, and a gasket 24 (called a spacer in the Office Action) positioned within the gasket 36. The gasket 24 is positioned to create channels 26 and 28 on the interior of the gasket 36. Given this position of the gasket 24, it cannot provide a pivot between the slide 50 and the base plate 12.

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Therefore, McGrath fails to teach a "spacer . . . providing a pivot between the substrate backing and the slide." It also fails to disclose a method comprising, "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide." Applicant respectfully requests withdrawal of the pending rejection.

**Anticipation Rejection over Halverson**

Claims 1, 2, 5, 6, 9, and 14 stand rejected under 35 U.S.C. § 102(c) as being anticipated by Halverson (U.S. Patent No. 6,913,931). Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 1 and its dependent claims set forth a slide, a substrate backing, "a gasket . . . having a perimeter," and a "spacer positioned outside the perimeter and providing a pivot between the substrate backing and the slide." Claim 14 sets forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

In sharp contrast, Halverson teaches a slide 470, a cover 482, an annular gasket 480 positioned between the slide and the cover, and an inner gasket 490 that functions as a spacer. Given the position of the spacer 490 inside the gasket 480, it cannot provide a pivot between the slide 470 and the cover 482.

Therefore, Halverson fails to disclose a "spacer . . . providing a pivot between the substrate backing and the slide." It also fails to disclose a method comprising, "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide." Applicant respectfully requests withdrawal of the pending rejection.

**Anticipation Rejection over Lyman**

Claims 1-3, 8, 11, 14, and 18 stand rejected under 35 U.S.C. § 102(c) as being anticipated by Lyman (U.S. Patent No. 6,555,361). Applicant respectfully traverses this rejection and does

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not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 1 and its dependent claims set forth a slide, a substrate backing, "a gasket . . . having a perimeter," and a "spacer positioned outside the perimeter and providing a pivot between the substrate backing and the slide." Claim 14 and its dependent claims set forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

In sharp contrast, Lyman discloses a clam-shell chamber having a top portion 12 and a base portion 14. The base portion 14 defines a groove 30 between raised portions 26 and 28. The inner raised portion 28 defines a contained region 32 that receives a slide. Col. 3, ll. 17-25. The slide is centered and within the contained region and not permitted to move. The slide does not engage the raised portions 26 or 29 or the gasket.

Therefore, Lyman fails to disclose a "spacer . . . providing a pivot between the substrate backing and the slide." It also fails to disclose a method comprising, "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide." Applicant respectfully requests withdrawal of the pending rejection.

**Anticipation Rejection over McGarry**

Claims 1-3, 8, 11, and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McGarry (U.S. Patent No. 6,642,046). Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 1 and its dependent claims set forth a slide, a substrate backing, "a gasket . . . having a perimeter," and a "spacer positioned outside the perimeter and providing a pivot between the substrate backing and the slide." Claim 14 sets forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

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In sharp contrast, McGarry teaches a base plate 32 that defines a cavity 40. A biochip 20 is seated in the cavity 40 and against o-rings 48, each o-ring surrounding a microarray 24. The biochip 20 sits on a raised portion of the base plate 32 within the cavity 40. The Final Office Action calls this raised portion of the base plate 32 a spacer. The entire perimeter of the biochip 20 rests on this raised portion. Even if the raised portion of the base plate 32 is a spacer, it cannot provide a pivot between the biochip and the base portion.

Therefore, McGarry fails to disclosed a "spacer . . . providing a pivot between the substrate backing and the slide." It also fails to disclose a method comprising, "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide." Applicant respectfully requests withdrawal of the pending rejection.

**C. Rejections Under 35 U.S.C. § 103(a)**

**Rejections over Halverson in view of McGrath in view of Merchant**

Claims 4, 7, and 10 stand rejected as being obvious over of Halverson in view of McGrath in view of Merchant (U.S. Patent No. 6,090,687). Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the office action.

Claims 4, 7, and 10 depend from claim 1 and hence set forth a slide, a substrate backing, a gasket having a perimeter, and a spacer positioned outside the perimeter and providing a pivot between the substrate backing and the slide.

As discussed above, Halverson and McGrath fail to teach these elements. Merchant is directed to a system and method for bonding and sealing microfabricated wafers. It also fails to disclose a gasket having a perimeter, and a spacer positioned outside the perimeter and providing a pivot between the substrate backing and the slide.

Therefore, no combination of the cited references will result in the claimed combination of elements. Applicant respectfully requests withdrawal of the pending rejection.

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**Rejection over Halverson in view of McGrath in view of Bargoot**

Claim 15 stands rejected as being obvious over Halverson in view of McGrath in view of Bargoot (U.S. Patent No. 6,750,039). Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 15 depends from claim 14 and hence sets forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

As discussed above, Halverson and McGrath fail to teach this element. Bargoot is directed to a filtration apparatus and method for the separation of microscopic entities from a fluid. A filter slide 101 is clamped in a clamshell-type slide holder 103. Bargoot also fails to disclose "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

Therefore, no combination of the cited references will result in the claimed combination of elements. Applicant respectfully requests withdrawal of the pending rejection.

**Obviousness Rejection over Halverson in view of McGrath in view of Stapleton**

Claim 16 stands rejected as being obvious over Halverson in view of McGrath in view of Stapleton (U.S. Patent No. 5,436,129). Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 16 depends from claim 14 and hence sets forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

As discussed above, Halverson and McGrath fail to teach this element. Stapleton is directed to a carrier 14 that has a hinge 18 between an upper piece 14 and a lower piece 16. A

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matrix 12 sits in a channel defined in the lower piece 16. Stapleton fails to disclose a gasket or a spacer that provides a pivot. Stapleton also fails to disclose "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide."

Therefore, no combination of the cited references will result in the claimed combination of elements. Applicant respectfully requests withdrawal of the pending rejection.

**Obviousness Rejection over Halverson in view of McGrath**

Claim 17 stands rejected as being obvious over Halverson in view of McGrath. Applicant respectfully traverses this rejection and does not concede any characterizations of the pending application or the cited references set forth in the Final Office Action.

Claim 17 depends from claim 14 and hence sets forth a method comprising "applying a force to the slide on one side of the spacer to separate at least a portion of the slide and the gasket from the substrate on an opposite side of the spacer, wherein the force causes a pivot between the spacer and the slide." As discussed above, Halverson and McGrath fail to teach this element. Therefore, no combination of the cited references will result in the claimed combination of elements. Applicant respectfully requests withdrawal of the pending rejection.

**D. Double Patenting**

The Final Office Action provisionally rejected claims 1-14 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over:

- 1.) Claims 1-15 of copending Application No. 10/797,764;
- 2.) Claims 1, 4-14, and 16-20 of copending Application No. 10/424,175; and
- 3.) Claims 1-3, 7, and 1-15 of copending Application No. 10/283,450.

Applicant requests that the Patent Office hold this rejection in abeyance until allowable subject matter has been indicated and one of these cited applications issues as a patent.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the pending claims are patentably distinct from the cited references and requests issuance of a Notice of Allowance.

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Applicant notes that there may be reasons that the pending claims are patentably distinct from the cited references and reserves the right to raise any such reason in the future. Please contact the undersigned, if a telephone conference would advance the prosecution of this application.

Respectfully submitted,

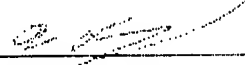
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